

Application No. 09/664,364  
Amendment dated  
Reply to Office Action of July 8, 2005

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**Amendments to the Drawings**

The attached sheet of drawings includes changes to Fig. 1. This sheet, which includes Figs. 1 and 2, replaces the original sheet including those same Figures.

Fig. 1 has been labeled as Conventional Art

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### **REMARKS**

Applicants thank the Examiner for the very thorough consideration given the present application.

Claims 12-28 are now present in this application. Claims 12, 13, 17, and 20 are independent. Claims 1-11 have been previously canceled without prejudice to being presented in a continuing patent application.

Reconsideration of this application, as amended, is respectfully requested.

#### **I. Title of the Invention**

The Examiner has required a new title, alleging that the existing title is not descriptive. The reason given is that the distinction focusing on the two field(s) ability for optimizing recording is not found in the title. Applicants respectfully traverse this requirement and submit that this feature is not found in all of the claims. Applicants do not want to amend the title to include a feature that is not part of the claims so as to mislead someone reading the title into believing that all of the claims include such a feature.

#### **II. Drawing Objection**

The Examiner has objected to the drawings. The Examiner states that Figure 1 should be designated by a legend such as --Prior Art--.

In order to address this objection, Applicants respectfully submit that the suggestion in MPEP § 608.02(g) of the use of the phrase --Prior Art-- does not exclude the use of alternate

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phrases, for example, "Background Art" and "Conventional Art". These alternative phrases may be found in many U.S. Patents issued today. The intent of MPEP § 608.02(g) is to distinguish Applicants' invention from that which is not Applicants' invention. If a drawing figure illustrates only material which is known to be statutory prior art to the invention, then the use of the phrase --Prior Art-- in the drawing figure would be proper. However, if it is not clear whether such material is statutory prior art, then the use of the phrase --Prior Art-- in the drawing figures would not be proper, and a label such as "Background Art" or "Conventional Art" would be more appropriate.

Applicants clearly indicate on page 1 that Fig. 1 illustrates the configuration of a conventional optical recording/reproducing apparatus. Applicants submit that the proposed drawing corrections filed as attachments to this Amendment, which include the label "Conventional Art" meet the criteria of MPEP § 608.02(g) and are sufficient to distinguish Applicants' invention from that which is not Applicants' invention. Accordingly, reconsideration and withdrawal of this objection, and approval of the proposed drawing corrections filed herewith, are respectfully requested.

### **III. Double Patenting Rejections**

Claim 13 stands rejected under the judicially created doctrine of double patenting over claim 3 of U.S. Patent 6,813,107 to Lee. Claim 13 also stands rejected under the judicially created doctrine of double patenting over claim 9 of U.S. Patent 6,404,712 to Lee et al. These two rejections are respectfully traversed.

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The basis for these rejections is said to be the decision in *In re Schneller*, 158 USPQ 210 (CCPA 1968). However, that decision is clearly limited to its facts. MPEP §804 states that non-statutory double patenting rejections based on Schneller will be rare.

In fact, MPEP §804 requires that for such a rejection to be made, the Technology Center (TC) Director must approve any non-statutory double patenting rejection based on Schneller.

There is no indication in this Office Action that the TC Director has approved this rejection. For example, the signature of the TC Director is not found in the Office Action, nor is any statement made that the TC Director's Approval has been obtained.

For this reason alone, the rejection is improper and must be withdrawn as violating established USPTO policy as set forth in MPEP §804.

Furthermore, MPEP §804 also clearly states that this type of rejection is to be made only where there is common inventorship – see page 800-28 of the August 2001 version of the MPEP.

The named inventor of Lee '107 is Jeong Yeol Lee, who is not a named inventor of this Application under rejection. The named Applicants of this patent Application are Jin Tae Roh and Bok Hyun Jo.

The named inventors of Lee et al. '712 are Seong Ju Lee and Dong Seok Bae, neither of which is a named inventor of this patent Application.

Because there is no common inventorship between this Application and either of the applied references, i.e., either Lee '107 or Lee et al. '712, this rejection is improper and should be withdrawn.

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Turning to the merits of the rejection of claim 13 based on Lee '107, Applicants respectfully note that a double patenting rejection is based on the claimed invention in the applied patent, not on the disclosed invention. This rejection clearly, and improperly, states that "the subject matter claimed in the instant application is fully disclosed in the patent . . ." The disclosure of the Lee '107 patent is irrelevant to the rejection if it is not claimed.

Moreover, claim 3 of Lee '107 does not recite (1) "a reproduction unit reproducing the test data" or (2) "a jitter measuring unit measuring respective jitters or reproduced signals outputted from the reproduction means." To allege that these features are inherent in a claim is without merit because all that is in a claim is what is positively recited in that claim. Clearly these two features are not recited in claim 3, nor are they inherently claimed.

The Office Action seems to be improperly relying on the doctrine of inherent disclosure, which relates to whether something is disclosed, not claimed.

Nor does claim 3 of Lee '107 recite a control unit determining an optimum write strategy based on jitters that are not measured.

With respect to the rejection of claim 13 over claim 9 of U.S. patent 6,404,712 to Lee et al (Lee '712), nowhere does Lee et al. '712 disclose a recording unit recording optional data as test data onto a test area of an optical recording medium while varying a format of recording signals. Nowhere is the recording of optional data "while varying a format of recording signals" recited in claim 8 of Lee et al. '712. Nor does claim 8 recite a jitter measuring unit measuring respective jitters of reproduced signals outputted from the reproduction means. Nor does the controlling means recited in Lee et al '712's last recited means determine an optimum write strategy based on measured jitters. In this regard, recording information indicative of whether to

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perform a procedure for obtaining an optimal recording condition has not been demonstrated to be the same as determining an optimum write strategy.

Moreover, the speculative statement in the rejection that there is no apparent reason why applicant was prevented from preventing claims directed to those of the instant application is incorrect because there is no common inventor involved between the instant Application and either of these two applied patents.

Accordingly these rejections of claim 13 are improper and should be withdrawn.

#### IV. Obviousness Type Double Patenting Rejections

Claim 13 stands rejected under the judicially created doctrine of obviousness type double patenting as unpatentable over claim 3 of U.S. Patent 6,813,107 to Lee in view of U.S. Patent 5,513,165 to Ide et al. ("Ide"). This rejection is respectfully traversed.

This is an alternatively stated rejection found on page 4 of the outstanding Office Action.

The factual inquiries set forth in Graham v. John Deere, 383 U.S. 1, 148 USPQ 459 (1966) that should be applied to establish a background for determining obviousness-type double patenting analysis are missing from the Office Action with respect to independent claims 1 and 5.

Because the rejection is based on 35 U.S.C. §103, what is in issue in such a rejection is "the invention as a whole", not just a small part of the preamble of the claimed invention. Under 35 U.S.C. §103, "[a] patent may not be obtained . . . if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would

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have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains." The determination under §103 is whether the claimed invention as a whole would have been obvious to a person of ordinary skill in the art at the time the invention was made. See In re O'Farrell, 853 F.2d 894, 902, 7 USPQ2d 1673, 1680 (Fed. Cir. 1988). In determining obviousness, the invention must be considered as a whole and the claims must be considered in their entirety. See Medtronic, Inc. v. Cardiac Pacemakers, Inc., 721 F.2d 1563, 1567, 220 USPQ 97, 101 (Fed. Cir. 1983). By failing to address all of the features of claims 1 and 5, the rejection fails to evaluate the invention as a whole and the rejection is improper and should be withdrawn.

Moreover, as pointed out in MPEP 804, because the analysis employed in an obviousness-type double patenting determination parallels the guidelines for a 35 U.S.C. 103(a) rejection, the factual inquiries set forth in Graham v. John Deere Co., 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103 are employed when making an obvious-type double patenting analysis. These factual inquiries are summarized as follows:

- (A) Determine the scope and content of a patent claim and the prior art relative to a claim in the application at issue;
- (B) Determine the differences between the scope and content of the patent claim and the prior art as determined in (A) and the claim in the application at issue;
- (C) Determine the level of ordinary skill in the pertinent art; and

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(D) Evaluate any objective indicia of nonobviousness.

The conclusion of obviousness-type double patenting is made in light of these factual determinations.

Any obviousness-type double patenting rejection should make clear:

(A) The differences between the inventions defined by the conflicting claims - a claim in the patent compared to a claim in the application; and

(B) The reasons why a person of ordinary skill in the art would conclude that the invention defined in the claim in issue is an obvious variation of the invention defined in a claim in the patent.

Applicant respectfully submits that a *prima facie* case of double patenting has not been established. As noted above, Lee's claim 3 does not claim the invention recited in Applicants' claim 13. So, even if it were obvious to modify Lee's claim 3 in view of Ide, which has not been shown to be the case, the resulting modification of Lee's claim 3 would not render the claimed invention obvious.

Nor does Ide provide a control unit that determines an optimum write strategy based on measured jitters. Ide merely measures the jitter of the recorded signal (col. 11, lines 34-65) but does not use it to control anything, let alone to determine a write strategy, as claimed.

The Office fails to make out a *prima facie* case of obviousness of the claimed invention in view of Ide who does not use jitter determinations to modify anything, let alone to determine a write strategy.

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Moreover, Applicants note that the Ide reference has not been listed in a Form PTO-892, nor has a copy of the patent been furnished to Applicants. Applicants respectfully request that this applied reference be cited on a Form PTO-892 in the next Office Action.

Claim 13 is also rejected under the judicially created doctrine of obviousness type double patenting as unpatentable over claim 9 of U.S. Patent 6,404,712 to Lee et al. in view of U.S. Patent 6,100,724 to Yoshimura et al. ("Yoshimura"). This rejection is respectfully traversed.

Applicant respectfully submits that a *prima facie* case of double patenting has not been established. As noted above, Lee et al's claim 9 does not claim the invention recited in Applicants' claim 13. So, even if it were obvious to modify Lee et al's claim 9 in view of Yoshimura, which has not been shown to be the case, the resulting modification of Lee et al's claim 9 would not render the claimed invention obvious.

Nor does Yoshimura provide a control unit that determines an optimum write strategy based on measured jitters. Yoshimura measures the jitter of the recorded signal (col. 11, lines 34-65) but does not use it to determine a write strategy, as claimed. Rather, Yoshimura merely uses the jitter for an offset adjustment of tracking servo and focusing servo – see the sentence bridging cols. 1 and 2 of Yoshimura.

The Office fails to make out a *prima facie* case of obviousness of the claimed invention in view of Yoshimura who does not use jitter determinations to determine a write strategy.

Reconsideration and withdrawal of this rejection of claim 13 is respectfully requested.

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Claim 14 stands rejected under the judicially created doctrine of obviousness type double patenting as unpatentable over (1) claim 3 of U.S. Patent 6,813,107 to Lee in view of U.S. Patent 5,732,061 to Kirino et al. ("Kirino") and (2) claim 9 of U.S. Patent 6,404,712 to Lee et al. in view of U.S. Patent 5,732,061 to Kirino et al. ("Kirino"). These rejections are respectfully traversed.

As noted above, Applicants respectfully submit that a *prima facie* case of double patenting has not been established. As noted above, Lee's claim 3 does not claim the invention recited in Applicants' claim 13. So, even if it were obvious to modify Lee's claim 3 in view of Kirino, which has not been shown to be the case, the resulting modification of Lee's claim 3 would not render the claimed invention obvious. Moreover, also as noted above, Applicants respectfully submit that a *prima facie* case of double patenting has not been established. As noted above, Lee et al's claim 9 does not claim the invention recited in Applicants' claim 13. So, even if it were obvious to modify Lee et al's claim 9 in view of Kirino, which has not been shown to be the case, the resulting modification of Lee et al's claim 9 would not render the claimed invention obvious.

Nor does Kirino provide a control unit that determines an optimum write strategy based on measured jitters. Kirino is directed to edge pit recording and indicates that jitter of the recorded signal is a problem under certain circumstances, (col. 2, lines 15-30 and col. 3, lines 19-35) but does not use it to determine a write strategy, as claimed. Rather, Kirino uses a trial write test pattern to determine an optimum laser power value and does not utilize jitter detection to modify its system.

Accordingly, the Office fails to make out a *prima facie* case of obviousness of the claimed invention in view of Kirino, who does not use jitter determinations to determine a write strategy.

Reconsideration and withdrawal of these rejections of claim 14 are respectfully requested.

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Claim 15 stands rejected under the judicially created doctrine of obviousness type double patenting as unpatentable over (1) claim 3 of U.S. Patent 6,813,107 to Lee in view of Kim ('965) and (2) claim 9 of U.S. Patent 6,404,712 to Lee et al. in view of Kim ('965). These rejections are respectfully traversed.

As noted above, Applicant respectfully submits that a *prima facie* case of double patenting has not been established. As noted above, Lee's claim 3 does not claim the invention recited in Applicants' claim 13. So, even if it were obvious to modify Lee's claim 3 in view of Kim ('965), which has not been shown to be the case, the resulting modification of Lee's claim 3 would not render the claimed invention obvious. Moreover, also as noted above, Applicants respectfully submit that a *prima facie* case of double patenting has not been established. As noted above, Lee et al's claim 9 does not claim the invention recited in Applicants' claim 13. So, even if it were obvious to modify Lee et al's claim 9 in view of Kim ('965), which has not been shown to be the case, the resulting modification of Lee et al's claim 9 would not render the claimed invention obvious.

Kim ('965) is applied to provide optimum power control to the base reference and permit backward compatibility. Applicants do not understand exactly how each base reference is to be modified in view of Kim ('965). Lee '107, for example discloses a method and apparatus for accomplishing optimal power calibration (OPC) and the Office Action fails to provide objective factual evidence of motivation to modify Lee '107 in some unspecified manner, to provide OPC, which Lee '107 already provides. Similar comments apply to the proposed modification of Lee et al '712, which also already uses OPC control.

The assertion of "backward compatibility" is not understood, nor is it explained.

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Accordingly, these rejections of claim 15 are improper and should be withdrawn.

Claim 16 stands rejected under the judicially created doctrine of obviousness type double patenting as unpatentable over (1) claim 3 of U.S. Patent 6,813,107 to Lee in view of U.S. Patent 6,813,807 to Maezawa and (2) claim 9 of U.S. Patent 6,404,712 to Lee et al. in view of U.S. Patent 6,813,807 to Maezawa. These rejections are respectfully traversed.

As noted above, Applicant respectfully submits that a *prima facie* case of double patenting has not been established. As noted above, Lee's claim 3 does not claim the invention recited in Applicants' claim 13. So, even if it were obvious to modify Lee's claim 3 in view of Maezawa, which has not been shown to be the case, the resulting modification of Lee's claim 3 would not render the claimed invention obvious. Moreover, also as noted above, Applicants respectfully submit that a *prima facie* case of double patenting has not been established. As noted above, Lee et al's claim 9 does not claim the invention recited in Applicants' claim 13. So, even if it were obvious to modify Lee et al's claim 9 in view of Maezawa, which has not been shown to be the case, the resulting modification of Lee et al's claim 9 would not render the claimed invention obvious.

Furthermore, there is no allegation that it would be obvious to modify each base reference in view of Maezawa, or a statement of how each base reference is supposed to be modified in view of Maezawa, or of what will result if each of the base references is modified in view of Maezawa. Accordingly, these rejections are incomplete and fundamentally improper and unsound.

The Office Action states that Maezawa further teaches "in this environment" the ability to calculate the "jitter" signal predicated on an "integration" of the signal difference.

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Actually, Maezawa does not detect jitter and use detected jitter to determine an optimum write strategy. Instead, Maezawa is directed to making a focus offset adjustment to reduce jitter.

The Office Action provides no objective factual evidence of any motivation to modify either base reference in view of Maezawa to achieve the claimed invention.

Reconsideration and withdrawal of these rejections of claim 16 is respectfully requested.

Claims 20 and 25 stand rejected under the judicially created doctrine of obviousness type double patenting as unpatentable over claim 3 of U.S. Patent 6,813,107 to Lee in view of Spruit et al. ("Spruit"). This rejection is respectfully traversed.

Applicant respectfully submits that a *prima facie* case of double patenting has not been established. As noted above, Lee et al's claim 9 does not claim the invention recited in Applicants' claim 13. So, even if it were obvious to modify Lee et al's claim 9 in view of Spruit, which has not been shown to be the case, the resulting modification of Lee et al's claim 9 would not render the claimed invention obvious.

Moreover, by stating that Spruit discloses a jitter detector, the Office Action admits that Lee does not disclose a jitter detector. Furthermore, claim 8 of Lee does not determine an optimum write strategy based on measured jitters.

Spruit fails to disclose any specific method of using jitter of a read signal to develop a write strategy. Spruit teaches that that jitter of a read signal is a read parameter that can be used for optimizing the value of one or more recording parameters. This is a general teaching of Spruit completely fails to provide any objective evidence of proper motivation for one of ordinary skill in the art to modify Lee '107 to provide an apparatus using a jitter detector signal

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to develop a write strategy. Lee already has a system that works well without the need to turn to Spruit to borrow any teachings, and neither Lee '107 nor Spruit discloses the recited recording test data onto a test area of an optical recording medium while varying a format of recording signals.

Accordingly, the Office Action fails to provide objective factual evidence to motivate a skilled worker to modify Lee '107, as suggested, fails to explain exactly what aspects of Lee '107 are to be modified, and even if such a modification were made, fails to render obvious the claimed invention.

Reconsideration and withdrawal of this rejection is respectfully requested.

Claim 21 stands rejected under the judicially created doctrine of obviousness type double patenting as unpatentable over claim 3 of U.S. Patent 6,813,107 to Lee in view of Spruit et al. ("Spruit") and further in view of Kirino. This rejection is respectfully traversed.

The Lee '107 – Spruit reference combination is improper and does not render the claimed invention recited in claim 20 obvious at least for reasons stated above. Moreover the additionally applied reference is not applied to supply the features missing from the Lee '107 – Spruit reference combination, so even if it were obvious to modify the base reference combination as suggested (which it is not at least for reasons discussed, *infra*), the resulting reference combination would not render the claimed invention obvious.

Kirino is applied to provide the claimed step of varying the focusing distance. The Office Action asserts that it would be obvious to provide such a feature in some unspecified manner to achieve the claimed invention, the motivation being to perform a better jitter performance.

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Applicants respectfully disagree. As noted above, Kirino does not provide a control unit that determines an optimum write strategy based on measured jitters. Kirino is directed to edge pit recording and indicates that jitter of the recorded signal is a problem under certain circumstances, (col. 2, lines 15-30 and col. 3, lines 19-35) but does not use it to determine a write strategy, as claimed. Rather, Kirino uses a trial write test pattern to determine an optimum laser power value and does not utilize jitter detection to modify its system.

Accordingly, the Office fails to make out a *prima facie* case of obviousness of the claimed invention in view of Kirino, who does not use jitter determinations to determine a write strategy.

Reconsideration and withdrawal of this rejection of claim 21 is respectfully requested.

Claim 22 stands rejected under the judicially created doctrine of obviousness type double patenting as unpatentable over claim 3 of U.S. Patent 6,813,107 to Lee in view of Spruit et al. ("Spruit") and further in view of Kim ('965). This rejection is respectfully traversed.

The Lee '107 – Spruit reference combination is improper and does not render the claimed invention recited in claim 20 obvious at least for reasons stated above. Moreover the additionally applied reference is not applied to supply the features missing from the Lee '107 – Spruit reference combination, so even if it were obvious to modify the base reference combination as suggested (which it is not at least for reasons discussed, *infra*), the resulting reference combination would not render the claimed invention obvious.

Kim ('965) is applied to provide optimum power control to the base reference and permit backward compatibility. Applicants do not understand exactly how each base reference is to be modified in view of Kim ('965). Lee '107, for example discloses a method and apparatus for

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accomplishing optimal power calibration (OPC) and the Office Action fails to provide objective factual evidence of motivation to modify Lee '107 in some unspecified manner, to provide OPC, which Lee '107 already provides. Similar comments apply to the proposed modification of Lee et al '712, which also already uses OPC control.

The assertion of "backward compatibility is not understood, nor is it explained.

Accordingly, this rejection of claim 22 is improper and should be withdrawn.

Claims 23-25 stand rejected under the judicially created doctrine of obviousness type double patenting as unpatentable over claim 3 of U.S. Patent 6,813,107 to Lee in view of Spruit et al. ("Spruit") and further in view of Sakaue et al. ("Sakaue"). This rejection is respectfully traversed.

The Lee '107 – Spruit reference combination is improper and does not render the claimed invention recited in claim 20 obvious at least for reasons stated above. Moreover the additionally applied reference is not applied to supply the features missing from the Lee '107 – Spruit reference combination, so even if it were obvious to modify the base reference combination as suggested (which it is not at least for reasons discussed, *infra*), the resulting reference combination would not render the claimed invention obvious.

Reconsideration and withdrawal of this rejection of claims 23-25 is respectfully requested.

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**Rejections under 35 U.S.C. §102**

Claims 12 and 26 stand rejected under 35 U.S.C. §102(b/e) as being anticipated or alternatively as being obvious over JP 3057875 further considered with either Honda et al. ("Honda") or Udagawa. This rejection is respectfully traversed.

Initially, Applicants note that this rejection is basically vague and indefinite. The rejection says that these claims are anticipated by JP 3057875 or, alternatively, over JP 3057875 in view of Honda or Udagawa, without indicating what aspects of the claims that JP 3057875 might be lacking and what aspects are being supplied by either of the two alternatively applied references.

Essentially, Applicants are left to speculate at the basis of this multiply alternative rejection for which an incorrect statutory basis is presented with respect to the obviousness rejection.

Under the circumstances, Applicants respectfully submit that this rejection denies them fundamental substantive and procedural due process under the Administrative Procedures Act and requires withdrawal of the rejection, at least to the extent that it relies on obviousness. As noted above, Applicants' rights under the Administrative Procedures Act are discussed, for example, in In re Zurko, 119 S.Ct. 1816, 50 USPQ2d 1930 (1999), and In re Gartside, 53 USPQ2d 1769 (Fed. Cir. 2000).

A prior art reference anticipates the subject of a claim when the reference discloses every feature of the claimed invention, either explicitly or inherently (see, In re Paulsen, 30 F.3d 1475, 1478, 1479, 31 USPQ2d 1671, 1675 (Fed. Cir. 1994), In re Spada, 911 F.2d 705, 708, 15 USPQ2d 1655, 1657 (Fed. Cir. 1990), Hazani v. Int'l Trade Comm'n, 126 F.3d 1473, 1477, 44 USPQ2d 1358, 1361 (Fed. Cir. 1997) and RCA Corp. v. Applied Digital Data Systems, Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984).

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Anticipation requires that each prior art reference contain within its four corners all of the elements of the claimed invention found in substantially the same situation where they do substantially the same work in the same way. *Atlas Powder Co. v. E.I. du Pont de Nemours and Co.*, 588 F.Supp. 1455 [ 221 USPQ 426 ] (N.D. Texas 1983), *aff'd*, 750 F.2d 1569 [ 224 USPQ 409 ] (Fed. Cir. 1984); *Ecolochem, Inc. v. Mobile Water Technology Co.*, 690 F.Supp. 778 [ 8 USPQ2d 1065 ] (E.D. Ark. 1988), *aff'd*, 871 F.2d 1096 [ 10 USPQ2d 1557 ] (Fed. Cir. 1989). Moreover, a rejection under 35 U.S.C. §102(e) cannot properly be based on speculation. See, in this regard, *In re GPAC, Inc.*, 35 USPQ2d 1116 at 1123 (Fed. Cir. 1995) and *Ex parte Haymond*, 41 USPQ2d 1217 at 1220 (Bd. Pat. App. & Int. 1996).

Furthermore, when relying on the theory of inherency, the Examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily follows from the teachings of the applied art. See, *Ex parte Levy*, 17 USPQ2d 1461, 1464 (BD. Pat. App. & Int. 1990). There can be no speculation or only possibilities involved in a holding of inherency. What is alleged to be inherent must necessarily occur. The mere fact that something may result from a given set of circumstances is not sufficient. *In re Oelrich*, 212 USPQ 323, 326 (CCPA 1991). "Inherent anticipation requires that the missing descriptive material is 'necessarily present,' not merely probably or possibly present, in the prior art." *Trintec Indus., Inc. v. Top-U.S.A. Corp.*, 295 F.3d 1292, 1295, 63 USPQ2d 1597, 1599 (Fed. Cir. 2002) (quoting *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999)).

Applicants will discuss JP 3057875.

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According to the computer generated translation of this document furnished by the U.S. Patent & Trademark Office, this reference does not anticipate several positively recited features of claim 12. For example, JP 3057875 does not disclose (1) recording optional data, as test data, onto a second field of the test area while varying a format of recording signals, using the determined optimum recording power value; or (2) reproducing the test data, recorded on the second field in accordance with the varied recording signal format, determining an optimum write strategy based on characteristics of the resultant reproduced signals, and storing the optimum write strategy.

With respect to item (1) in the previous paragraph, the Office Action only mentions that JP 3057875 only discloses plural fields in the test area. This does not address the rest of the recited feature, including "while varying a format of recording signals." The Office Action does not point out where this feature is found in JP 3057875 and Applicants have been unable to find this feature disclosed by that reference.

With respect to item (2), the last clause of the claim, the Office Action refers to the computer generated English translation (MAT) starting at paragraph 10. Actually, the MAT has 29 numbered paragraphs and Applicants have not been able to find this claimed feature disclosed anywhere in paragraphs 10-29 of the MAT of JP 3057875. For example, Applicants cannot find any disclosure of reproducing the test data recorded in the second field with the varied recording signal format.

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Accordingly, the Office Action fails to provide objective factual evidence that JP 3057875 anticipates the invention recited in claims 12 and 26.

Reconsideration and withdrawal of this rejection of claims 12 and 26 are respectfully requested.

Claim 26 is rejected under 35 U.S.C. §103(a) as unpatentable over JP 3057875 further considered with either Honda et al. ("Honda") or Udagawa, and even further in view of PCT/WO01/15148 to Ogawa et al. ("Ogawa") (actually, the U.S. equivalent Patent 6,859,426). This rejection is respectfully traversed.

Initially, Applicants are unclear why this rejection is being made because this claim, i.e., claim 26, has already been rejected over three references, and now a fourth reference is being added without any explanation of why the previously applied three references do not render the claimed invention obvious.

Moreover, claim 12, from which claim 26 depends, is neither anticipated by JP 3057875 nor rendered obvious over JP 3057875 in view of Honda or Udagawa, at least for reasons stated above. Additionally, because Ogawa is not applied to remedy any of the aforementioned deficiencies in the base reference/reference combination, this rejection does not tender the claimed invention recited in claim 26 obvious.

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Ogawa is allegedly applied to "add additional factors/parameters as part of the optional test data so as to permit use of alternate formatted discs available in the market place" to increase flexibility of the overall system.

Unfortunately, claim 26 does not recite adding additional factors/parameters as part of the optional test data, so Applicants are unsure why this feature is addressed in the rejection of claim 26.

Reconsideration and withdrawal of this rejection of claim 26 is respectfully requested.

Claim 27 stands rejected under 35 U.S.C. §103(a) as unpatentable over JP 3057875 further considered with either Honda et al. ("Honda") or Udagawa, and even further in view of Yoshida et al. ("Yoshida"). This rejection is respectfully traversed.

Claim 12, from which claim 27 depends, is neither anticipated by JP 3057875 nor rendered obvious over JP 3057875 in view of Honda or Udagawa, at least for reasons stated above. Additionally, because Yoshida is not applied to remedy any of the aforementioned deficiencies in the base reference/reference combination, this rejection does not tender the claimed invention recited in claim 27 obvious.

The Office Action never discloses what Yoshida has to do with determining the optimum recording power value based on asymmetries of the reproduced signals. All that the Office Action states about what is disclosed by Yoshida is that Yoshida teaches the ability of calculation/measuring and performing appropriate write strategy decisions.

Accordingly, the Office Action fails to make out a *prima facie* case of proper motivation to use Yoshida to modify the base reference combination, or how to modify the base reference combination to achieve, or render obvious, the claimed invention recited in claim 27.

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Moreover, even if the base reference combination were somehow modified in view of Yoshida's asymmetry measuring section 18, discussed, for example, in col. 15, lines 1-22, the Office Action provides no guidance to a skilled worker as to how the base reference combination is to be modified, or how to achieve a workable device as a result, and even if the proposed modification of the base reference combination were accomplished, the Office Action fails to explain how the features missing from the base reference combination, discussed above, would be provided by Yoshida.

Accordingly, this rejection is improper and should be withdrawn.

Claim 28 stands rejected under 35 U.S.C. §103(a) as unpatentable over JP 3057875 further considered with either Honda et al. ("Honda") or Udagawa, and even further in view of Osakabe. This rejection is respectfully traversed.

Claim 12, from which claim 28 depends, is neither anticipated by JP 3057875 nor rendered obvious over JP 3057875 in view of Honda or Udagawa, at least for reasons stated above. Additionally, because Osakabe is not applied to remedy any of the aforementioned deficiencies in the base reference/reference combination, this rejection does not tender the claimed invention recited in claim 27 obvious.

Osakabe discloses that the HF signal recorded with the writing power  $P_w$  just below the saturation level was found to present the least jitters and errors, and hence such writing power intensity  $P_w$  just below the saturation level can be determined as an optimum writing power intensity value  $P_{wo}$  (col. 4, lines 31-44).

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However, the Office Action never explains why this teaching would motivate one of ordinary skill in the art to modify the base reference combination to render obvious the claimed invention, including providing in the base reference combination, the features missing from the base reference combination, as set forth above. The Office Action merely states that in view of Osakabe it would be obvious to "provide a system optimized accordingly." However, the Office Action never addresses why, in view of Osakabe, it would be obvious to modify the base reference combination to disclose (1) record optional data, as test data, onto a second field of the test area while varying a format of recording signals, using the determined optimum recording power value; or (2) reproduce the test data, recorded on the second field in accordance with the varied recording signal format, determining an optimum write strategy based on characteristics of the resultant reproduced signals, and storing the optimum write strategy.

Accordingly, this rejection of claim 28 is improper and should be withdrawn.

Claims 13 and 15 stand rejected under 35 U.S.C. §102(b) as anticipated by, or in the alternative under 35 U.S.C. 103(a) as obvious over, JP 3057875 further considered with Ishibashi et al. ("Ishibashi"). These rejections are respectfully traversed.

Initially, Applicants note that this rejection is basically vague and indefinite. The rejection says that these claims are anticipated by JP 3057875 or, alternatively, over JP 3057875 in view of Ishibashi without indicating what aspects of the claims that JP 3057875 might be lacking and what aspects are being supplied by either of the two alternatively applied references.

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Essentially, Applicants are left to speculate at the basis of this multiply alternative rejection for which an incorrect statutory basis is presented with respect to the obviousness rejection.

Under the circumstances, Applicants respectfully submit that this rejection denies them fundamental substantive and procedural due process under the Administrative Procedures Act and requires withdrawal of the rejection, at least to the extent that it relies on obviousness. As noted above, Applicants' rights under the Administrative Procedures Act are discussed, for example, in In re Zurko, 119 S.Ct. 1816, 50 USPQ2d 1930 (1999), and In re Gartside, 53 USPQ2d 1769 (Fed. Cir. 2000).

Applicants will discuss JP 3057875.

According to the computer generated translation of this document furnished by the U.S. Patent & Trademark Office, this reference does not anticipate several positively recited features of claim 13. For example, JP 3057875 does not disclose (1) a recording unit recording optional data, as test data, onto a test area of an optical recording medium while varying a format of recording signals; or (2) a jitter measuring unit and a control unit determining an optimum write strategy based on the measured jitters.

With respect to item (1) in the previous paragraph, the Office Action only mentions that JP 3057875 only discloses, in paragraph 3, reading OPC test area. This does not address the recited feature, including "while varying a format of recording signals." The Office Action does not point out where this feature is found in JP 3057875 and Applicants have been unable to find this feature disclosed by that reference.

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With respect to item (2), the last clause of the claim, the Office Action refers to the computer generated English translation (MAT) starting at paragraph 10. Actually, the MAT has 29 numbered paragraphs and Applicants have not been able to find this claimed feature disclosed anywhere in paragraphs 10-29 of the MAT of JP 3057875. For example, Applicants cannot find any disclosure of a jitter measuring unit a jitter measuring unit and a control unit determining an optimum write strategy based on the measured jitters.

Ishibashi is directed to optimizing the focusing position of an optical pickup and detects jitter for that purpose, not for determining a write strategy. The Office Action completely fails to demonstrate why one of ordinary skill in the art would look to Ishibashi for anything to do with determining an optimum write strategy. In fact, the only apparent nexus between the base reference and this secondary reference is Applicant's disclosed invention, which means that this rejection is improperly based on hindsight reconstruction of Applicant's invention based solely on Applicants' disclosure.

Accordingly, the Office Action fails to provide objective factual evidence that JP 3057875 anticipates the invention recited in claims 13 and 15, or that these claims are obvious over the applied references..

Reconsideration and withdrawal of this rejection of claims 13 and 15 are respectfully requested.

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Claim 14 stands rejected under 35 U.S.C. §102(b) as anticipated by, or in the alternative under 35 U.S.C. § 103(a) as obvious over, JP 3057875 further considered with Ishibashi et al. ("Ishibashi"). This rejection is respectfully traversed.

Applicants traverse this rejection for the reasons presented above with respect to the traversal of claim 13. Furthermore, the Office Action fails to provide objective factual evidence to support a conclusion that one of ordinary skill in the art would be motivated to look to Ishibashi to improve write strategy because Ishibashi is not disclosed as being directed to such an invention. Ishibashi is directed to optimizing the focusing position of an optical pickup and detects jitter for that purpose, not for determining a write strategy. The Office Action completely fails to demonstrate why one of ordinary skill in the art would look to Ishibashi for anything to do with determining an optimum write strategy. In fact, the only apparent nexus between the base reference and this secondary reference is Applicant's disclosed invention, which means that this rejection is improperly based on hindsight reconstruction of Applicant's invention based solely on Applicants' disclosure.

Accordingly, the Office Action fails to make out a *prima facie* case of anticipation by, or obviousness of the claimed invention, over the applied art.

Claim 16 stands rejected under 35 U.S.C. §102(b) as anticipated by, or in the alternative under 35 U.S.C. § 103(a) as obvious over, JP 3057875 further considered with Maezawa. These rejections are respectfully traversed.

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Applicants will discuss JP 3057875.

According to the computer generated translation of this document furnished by the U.S. Patent & Trademark Office, this reference does not anticipate several positively recited features of claim 13. For example, JP 3057875 does not disclose (1) an optical recording medium having a test area with a first field on which a value of a factor having an influence on recording characteristics is recorded, as test data, while being varied, and recording unit recording test data onto a test area of an optical recording medium while varying a format of recording signals; or (2) a jitter measuring unit and a control unit determining an optimum write strategy based on the measured jitters.

With respect to item (1) in the previous paragraph, the Office Action only mentions that JP 3057875 only discloses, in paragraph 3, reading opc test area. This does not address the recited feature, including "while varying a format of recording signals." The Office Action does not point out where this feature is found in JP 3057875 and Applicants have been unable to find this feature disclosed by that reference.

With respect to item (2), the last clause of the claim, the Office Action refers to the computer generated English translation (MAT) starting at paragraph 10. Actually, the MAT has 29 numbered paragraphs and Applicants have not been able to find this claimed feature disclosed anywhere in paragraphs 10-29 of the MAT of JP 3057875. For example, Applicants cannot find any disclosure of a jitter measuring unit a jitter measuring unit and a control unit determining an optimum write strategy based on the measured jitters.

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The Office Action states that Maezawa further teaches "in this environment" the ability to calculate the "jitter" signal predicated on an "integration" of the signal difference.

Actually, Maezawa does not detect jitter and use detected jitter to determine an optimum write strategy. Instead, Maezawa is directed to making a focus offset adjustment to reduce jitter.

The Office Action provides no objective factual evidence of any motivation to modify the base reference in view of Maezawa to achieve the claimed invention.

Reconsideration and withdrawal of these rejections of claim 16 is respectfully requested.

Claims 17-19 stand rejected under 35 U.S.C. §102(b) as anticipated by, or in the alternative under 35 U.S.C. § 103(a) as obvious over, JP 3057875 further considered with JP 07-287847. These rejections are respectfully traversed.

The Office Action refers to "the above analysis" of JP 3057875 with respect to the rejection of claims 17-19. However, claim 17 is an independent claim reciting an optical recording medium, and none of the claims previously analyzed with respect to JP 3057875 are optical medium claims. Thus, the Office Action fails to present a meaningful analysis of the claimed invention. For this reason alone, the rejection is fundamentally improper and should be withdrawn.

JP 3057875 clearly does not disclose an optical medium having a second field on which is recorded the value of another factor that includes a format of recording pulse for a determination of a recording signal format including an optimum recording condition, as recited.

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This feature is clearly not addressed in the rejection of claims 17-19 and, for at least that reason, the Office Action fails to make out a *prima facie* case of obviousness of the claimed invention.

The Office Action turns to JP 07-287847 to provide whatever is missing from JP 3057875. Unfortunately, JP 07-287847 fails to disclose or suggest the missing feature of an optical medium having a second field on which is recorded the value of another factor that includes a format of recording pulse for a determination of a recording signal format including an optimum recording condition, as recited.

The Office Action believes that whatever is missing from the base reference is shown in paragraphs 20-35 of JP 07-287847. However, the Office Action never explains why the content of these paragraphs, which discuss a modulation factor detector and a calculator for a beta value discloses this missing feature.

Moreover, the Office Action provides no statement of why one of ordinary skill in the art would be motivated to modify the base reference in view of the secondary reference, or what would result from the proposed modification, thereby additionally failing to make out a *prima facie* case of obviousness of the claimed invention.

Reconsideration and withdrawal of this rejection is respectfully requested.

Claims 13 and 15 stand rejected under 35 U.S.C. §102(b) as anticipated by, or under 35 U.S.C. §103(a) as obvious over, JP 07-287847 further considered with Ishibashi. These rejections are respectfully traversed.

Initially, Applicants respectfully submit that this rejection is merely cumulative to the other rejections of the same claims and that plural rejections of the same claims under 35 U.S.C.

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§102(b)/103 should not be made where MPEP §706.02 to limit rejections to the best prior art available.

For this reason alone, this rejection should be withdrawn.

Secondly, Applicants note that this rejection is basically vague and indefinite. The rejection says that these claims are anticipated by JP 07-287847 or, alternatively, over JP 07-287847 in view of Ishibashi without indicating what aspects of the claims that JP 07-287847 might be lacking and what aspects are being supplied by either of the two alternatively applied references.

Essentially, Applicants are left to speculate at the basis of this multiply alternative rejection for which an incorrect statutory basis is presented with respect to the obviousness rejection.

Under the circumstances, Applicants respectfully submit that this rejection denies them fundamental substantive and procedural due process under the Administrative Procedures Act and requires withdrawal of the rejection, at least to the extent that it relies on obviousness. As noted above, Applicants' rights under the Administrative Procedures Act are discussed, for example, in In re Zurko, 119 S.Ct. 1816, 50 USPQ2d 1930 (1999), and In re Gartside, 53 USPQ2d 1769 (Fed. Cir. 2000).

Thirdly, while JP 07-287847 does disclose a jitter appearance circuit 8 and a control unit that selects an optimum laser power based, in part, on input from the jitter appearance unit, JP 07-287847 does not determine an optimum write strategy, but merely determines an optimum write power. Additionally, JP 07-287847 does not disclose a recording unit recording optional data, as test data, onto a test area of an optical recording medium while varying a format of recording signals, as recited. This last mentioned feature is not met by JP 07-287847 because all that is varied is laser write power, not signal format.

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Accordingly, JP 07-287847 does not anticipate the claimed invention.

Nor does the combination of JP 07-287847 and Ishibashi render the claimed invention obvious, at least for the aforementioned reasons. Additionally, as pointed out above, Ishibashi is directed to optimizing the focusing position of an optical pickup and detects jitter for that purpose, not for determining a write strategy. The Office Action completely fails to demonstrate why one of ordinary skill in the art would look to Ishibashi for anything to do with determining an optimum write strategy. In fact, the only apparent nexus between the base reference and this secondary reference is Applicant's disclosed invention, which means that this rejection is improperly based on hindsight reconstruction of Applicant's invention based solely on Applicants' disclosure.

Accordingly, claims 13 and 15 are not anticipated by JP 07-287847 or rendered obvious by that reference in view of Ishibashi.

Reconsideration and withdrawal of this rejection is respectfully requested.

Claim 14 stands rejected under 35 U.S.C. §102(b) as anticipated by, or in the alternative under 35 U.S.C. § 103(a) as obvious over, JP 07-287847 further considered with Ishibashi et al. ("Ishibashi"). This rejection is respectfully traversed.

While JP 07-287847 does disclose a jitter appearance circuit 8 and a control unit that selects an optimum laser power based, in part, on input from the jitter appearance unit, JP 07-287847 does not determine an optimum write strategy, but merely determines an optimum write

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power. Additionally, JP 07-287847 does not disclose a recording unit recording optional data, as test data, onto a test area of an optical recording medium while varying a format of recording signals, as recited. This last mentioned feature is not met by JP 07-287847 because all that is varied is laser write power, not signal format.

Accordingly, JP 07-287847 does not anticipate the claimed invention.

Nor does the combination of JP 07-287847 and Ishibashi render the claimed invention obvious, at least for the aforementioned reasons. Additionally, as pointed out above, Ishibashi is directed to optimizing the focusing position of an optical pickup and detects jitter for that purpose, not for determining a write strategy. The Office Action completely fails to demonstrate why one of ordinary skill in the art would look to Ishibashi for anything to do with determining an optimum write strategy. In fact, the only apparent nexus between the base reference and this secondary reference is Applicant's disclosed invention, which means that this rejection is improperly based on hindsight reconstruction of Applicant's invention based solely on Applicants' disclosure.

Accordingly, claim 14 is not anticipated by JP 07-287847 or rendered obvious by that reference in view of Ishibashi.

Reconsideration and withdrawal of this rejection is respectfully requested.

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Claim 16 stands rejected under 35 U.S.C. §102(b) as anticipated by, or in the alternative under 35 U.S.C. § 103(a) as obvious over, JP 07-287847 further considered with Maezawa. This rejection is respectfully traversed.

While JP 07-287847 does disclose a jitter appearance circuit 8 and a control unit that selects an optimum laser power based, in part, on input from the jitter appearance unit, JP 07-287847 does not determine an optimum write strategy, but merely determines an optimum write power. Additionally, JP 07-287847 does not disclose a recording unit recording optional data, as test data, onto a test area of an optical recording medium while varying a format of recording signals, as recited. This last mentioned feature is not met by JP 07-287847 because all that is varied is laser write power, not signal format.

Accordingly, JP 07-287847 does not anticipate the claimed invention.

Nor does the combination of JP 07-287847 and Maezawa render the claimed invention obvious, at least for the aforementioned reasons.

The Office Action states that Maezawa further teaches "in this environment" the ability to calculate the "jitter" signal predicated on an "integration" of the signal difference.

Actually, Maezawa does not detect jitter and use detected jitter to determine an optimum write strategy. Instead, Maezawa is directed to making a focus offset adjustment to reduce jitter.

The Office Action provides no objective factual evidence of any motivation to modify the base reference in view of Maezawa to achieve the claimed invention.

Reconsideration and withdrawal of these rejections of claim 16 is respectfully requested.

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Claims 20, 23 and 25 stand rejected under 35 U.S.C. §102(b) as anticipated by either JP 07-278847 or JP 305875. These rejections are respectfully traversed.

Initially, Applicants respectfully submit that this rejection violates the provisions of MPEP §706.02 to limit rejections to the best prior art available.

For this reason alone, this rejection should be withdrawn.

Secondly, as pointed out above, neither of the applied references discloses recording test data onto a test area of an optical recording medium while varying a format of recording signals, as recited, nor do they determine an optimum write strategy based on the measured jitters, as explained above.

Accordingly, this rejection is improper and should be withdrawn.

Claim 21 stands rejected under the art applied in the rejection of claim 20 and further in view of Kirino. This rejection is respectfully traversed.

The art applied in the rejection of claim 20 does not render claim 20 unpatentable at least for reasons stated above.

Kirino is directed to edge pit recording and indicates that jitter of the recorded signal is a problem under certain circumstances, (col. 2, lines 15-30 and col. 3, lines 19-35) but does not use it to determine a write strategy, as claimed. Rather, Kirino uses a trial write test pattern to determine an optimum laser power value and does not utilize jitter detection to modify its system.

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Accordingly, the Office fails to make out a *prima facie* case of obviousness of the claimed invention in view of either base reference modified based on Kirino, who does not use jitter determinations to determine a write strategy.

Reconsideration and withdrawal of this rejection is respectfully requested.

Claim 20 stands rejected under the art applied in the rejection of claim 20 and further in view of Kim ('965). This rejection is respectfully traversed.

The art applied in the rejection of claim 20 does not render claim 20 unpatentable at least for reasons stated above.

Kim ('965) is applied to provide optimum power control to either base reference and permit backward compatibility. Applicants do not understand exactly how each base reference is to be modified in view of Kim ('965), especially when neither reference has been demonstrated to need the proposed "additional opc capability." Both base references already have OPC capability and the Office Action fails to provide objective factual evidence of motivation to modify either reference in some unspecified manner, to provide OPC, which they already provide.

Accordingly, this rejection is improper and should be withdrawn.

Claims 24 stand rejected under 35 U.S.C. §103(a) as being unpatentable over the art applied in the rejection of claim 20 and further in view of JP 07-287847. This rejection is respectfully traversed.

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This rejection is really confusing because the art applied in the rejection of claim 20 included JP 07-287847, the very reference that is being proposed to be modified by that very same reference.

Clarification is required before Applicants can address the merits of this rejection.

To the extent that this confusing rejection relies on modifying JP 3057875 in view of JP 07-287847, it is traversed because the Office Action contains no statement of why one of ordinary skill in the art would be motivated to modify JP 3057875 in view of JP 07-287847 and lets Applicants speculate at what such motivation might be. Thus, a *prima facie* case of proper motivation to combine these two references is missing and renders the rejection fundamentally improper.

Moreover, for reasons stated above, neither applied reference anticipates or renders obvious the claimed invention. The proposed modification of the base reference by the secondary reference fails to remedy these deficiencies.

Accordingly, the rejection is improper and should be withdrawn.

## VII. Additional Cited References

Because the remaining references cited by the Examiner have not been utilized to reject the claims, but have merely been cited to show the state of the art, no comment need be made with respect thereto.

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### CONCLUSION

All of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding rejections and that they be withdrawn. It is believed that a full and complete response has been made to the outstanding Office Action, and as such, the present application is in condition for allowance.

Applicants also respectfully request that the newly applied U.S. Patent 5,513,165 to Ide et al. be listed on a Form PTO-892.

If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone Robert J. Webster, Registration No. 46,472, at (703) 205-8000, in the Washington, D.C. area.

Prompt and favorable consideration of this Amendment is respectfully requested.

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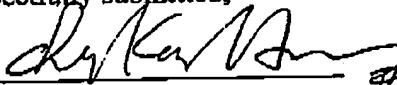
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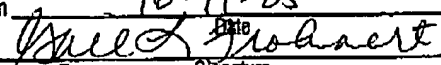
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If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies,  
to charge payment or credit any overpayment to Deposit  
Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly,  
extension of time fees.

Dated: October 11, 2005

Respectfully submitted,

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Fig. 1

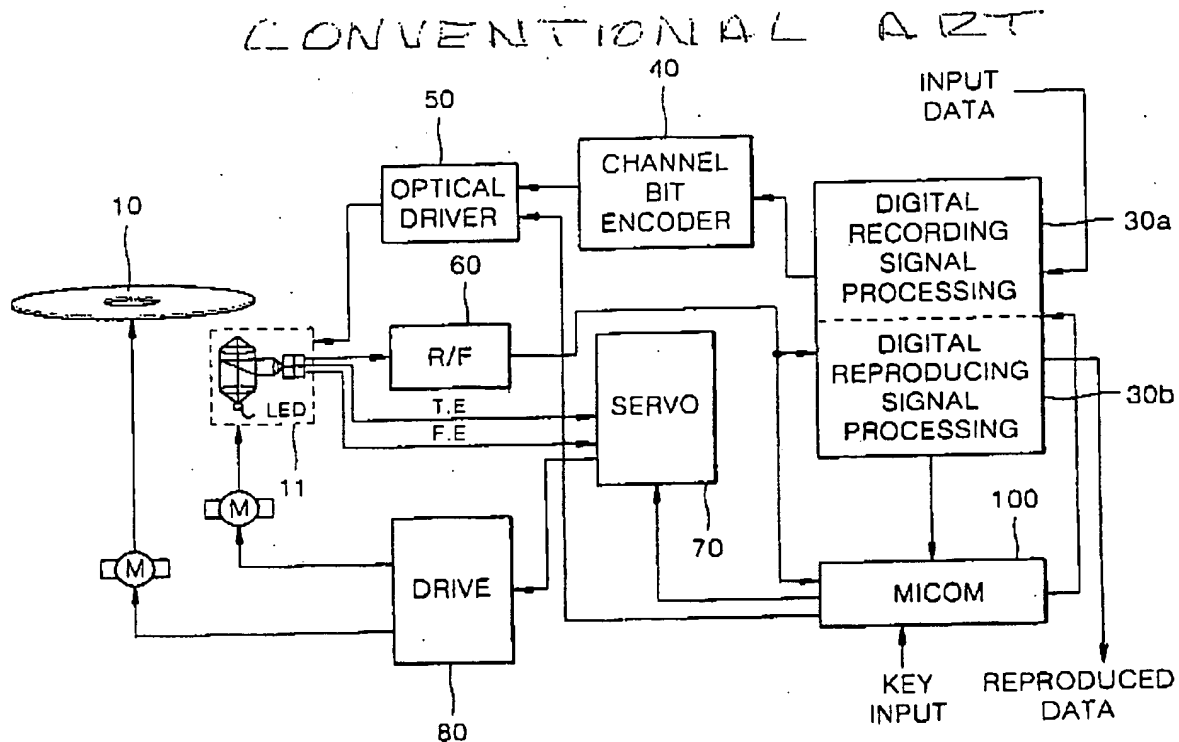
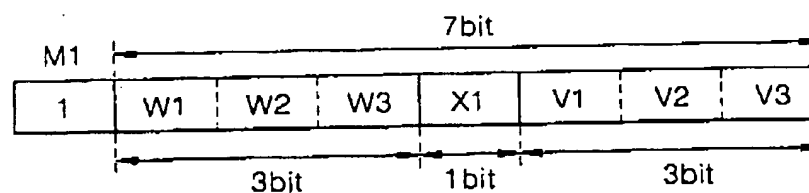


Fig. 2



'Minute' Byte when M1 : S1 : F1 = 101

W1, W2, W3	= 000	---	P <sub>ind</sub> = 5mw
	= 001	---	P <sub>ind</sub> = 6mw
	= 010	---	P <sub>ind</sub> = 7mw
	= 011	---	P <sub>ind</sub> = 8mw
	= 100	---	P <sub>ind</sub> = 9mw
	= 101	---	P <sub>ind</sub> = 10mw
	= 110	---	P <sub>ind</sub> = 11mw
	= 111	---	P <sub>ind</sub> = 12mw

W1, W2, W3 : Indicative Target Writing Power (P<sub>ind</sub>)  
 X1 : Reserved Future Extensions (=0)